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NOVARTIS VACCINES AND DIAGNOSTICS INC.
INTELLECTUAL PROPERTY- X100B
P.O. BOX 8097
Emeryville CA 94662-8097

In re Application of :
COSTANTINO, et al. :
Application No.: 10/574,437 : DECISION ON PETITION
PCT No.: PCT/IB2004/003366 :
Int. Filing Date: 04 October 2004 : UNDER 37 CFR 1.181
Priority Date: 02 October 2003 :
Attorney Docket No.: PP021389.0013 :
For: HYPO- AND HYPER-ACETYLATED :
MENINGOCOCCAL CAPSULAR :
SACCHARIDES :
:

This decision is in response to applicant's "REPLY TO NOTIFICATION OF ABANDONMENT" filed 02 March 2009 in the United States Patent and Trademark Office (USPTO). The reply is being treated as a petition under 37 CFR 1.181 to withdraw the holding of abandonment. No petition fees are required.

BACKGROUND

On 04 October 2004, applicant filed international application PCT/IB2004/003366, which claimed priority of an earlier application filed 02 October 2003. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 14 April 2005. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 04 April 2006.

On 03 April 2006, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1).

On 26 February 2007, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicant of the need to provide an executed oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International Application number and international filing date. Applicant was given two months to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 25 April 2007, responded with a declaration executed by Paolo Costantino and

Francesco Berti.

On 27 August 2007, applicant was mailed a NOTIFICATION OF DEFECTIVE RESPONSE (Form PCT/DO/EO/916) indicating that the filed declaration was defective as it listed Francesco Berti as an inventor while Francesco Berti did not appear on the published international application. Applicant was afforded one month from the mailing of the Form PCT/DO/EO/916 or the amount of extendable time from the mail date of the Form PCT/DO/EO/905 to file a proper reply.

On 20 February 2009, applicant was mailed a "Notification of Abandonment" (Form PCT/DO/EO/909) for failure to respond to the Form PCT/DO/EO/916 mailed 27 August 2007.

On 04 March 2009, applicant filed the present petition indicating that a response had been filed on 27 September 2007 and requesting withdrawal of the holding of abandonment.

On 07 July 2009, applicant filed a petition under 37 CFR 1.48(a) to add Francesco Berti as an inventor in the application.

DISCUSSION

The best evidence of what was actually received by the Office is a postcard receipt containing a specific itemization of all the items being submitted. See MPEP 503. Here, applicant has provided a copy of the date-stamped postcard receipt. The postcard identifies the application by application number, applicant and docket number. Among the items listed on the receipt is "Response to Defective Response." The receipt is stamped "IAP6 REC'D PCT/PTO 01 OCT 2007" across its face. Thus, it is clear that applicant filed a response with the USPTO on 01 October 2007. A review of the review finds that it contains certification under 37 CFR 1.8 that the filing was deposited for mailing on 27 September 2007 and therefore was a timely response to the Form PCT/DO/EO/916 mailed 27 August 2007. However, a review of the filing itself finds that it was not a proper reply to the Form PCT/DO/EO/916. Applicant did not file a petition under 37 CFR 1.497(d) to add Francesco Berti as an inventor, but merely indicated that Francesco Berti should have been listed as an inventor and that the error occurred without deceptive intent. This response is insufficient and therefore the application was properly abandoned.

RECOMMENDATION

Applicant may wish to consider filing a petition to the Commissioner under 37 CFR 1.137(a) or (b) requesting that the application be revived. Any petition filed under 37 CFR 1.137(a) and/or a petition under 37 CFR 1.137(b) requesting that the application be revived must meet the criteria indicated in the recent revision of 37 CFR 1.137. See 62 Fed. Reg. 53131 (October 10, 1997); 1203 Off. Gaz. Pat. Office 63 (October 21, 1997) (Effective Date: 01 December 1997).

This recommendation to file a petition under 37 CFR 1.137(a) or (b) should not be construed as an indication as to whether or not any such petition(s) will be favorably considered.

CONCLUSION

For the reasons detailed above, applicant's petition under 37 CFR 1.181 is **DISMISSED**.

The application remains abandoned.

A decision on applicant's petition under 37 CFR 1.48(a) filed 07July 2009 will be held in abeyance pending resolution of the abandonment of the application.

Any reconsideration on the merits of this petition must be filed within **TWO (2)** **MONTHS** from the mail date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: (703) 305-0130
Fax: (703) 308-6459